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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

En-Seung Kang et al.

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| Serial No.: | 09/217,932 | Examiner: | K. Zand |
| Filed: | 22 December 1998 | Art Unit: | 2132 |

For: DIGITAL CONTENT ENCRYPTION APPARATUS AND METHOD THEREOF

**PETITION UNDER 37 CFR §1.144**



The Honorable Commissioner
of Patents & Trademarks
Washington, D.C. 20231

Sir:

In response to the Office action (Paper No. 9), mailed 12 December 2002, entry and consideration of the following timely filed petition is respectfully requested.

Folio: P55501
Date: 12/31/02
I.D.: REB/MDP

## STATEMENT OF FACTS

1) A restriction was mailed 23 July 2002 (Paper No. 5) requiring applicant to elect between the inventions of Group I, covered by claims 1-19 and 37-44 drawn to an apparatus and method of copy protection by storing key information classified in Class 713, subclass 193, Group II covered by claims 20-33 drawn to an apparatus and method of copy protection using packet header classified in class 713 subclass 160, Group III covered by claims 34-35 and 52-53 drawn to an apparatus and method of user access classified in class 713 subclass 182, Group IV covered by claim 36 drawn to a method of authenticating through registration authority classified in class 713 subclass 155, Group V covered by claims 45-61 and 66-69 drawn to a method of cryptography using code signal classified in class 380 subclass 239, Group VI covered by claims 54- 56 drawn to a method of key distribution classified in class 380 subclass 278, and Group VII covered by claims 57-65 drawn to a method of copy prevention and protection classified in class 380 subclass 201.

2) On 22 October 2002 Applicant filed an Election with traverse electing the invention of Group II, claims 20-33.

3) On 12 December 2002 the Examiner mailed a "nonfinal" Office action (Paper No. 9) on the merits maintaining the Restriction by making the Restriction requirement final.

## ARGUMENTS AND/OR REMARKS

Traversal was on the grounds that the Examiner erred by stating that the inventions are subcombinations disclosed as usable together, by stating that each has separate utility, and the Examiner has improperly classified the various claims in different classes and subclasses or in the incorrect classes and subclasses.

Group I calls for a *copyright protection protocol having a header and being formed by adding the encrypted digital contents to the header.*

The Examiner has indicated that claims drawn to an apparatus and method of copy protection using a header are to be classified in class 713 subclass 160. See the classification of Group II, claims 20-33, which call for *copyright protection protocol including a header and digital contents, said digital contents being encrypted.*

The Examiner errs by stating that Group I has separate utility "such as data protection by storing," whereas Group II has separate utility "such as data protection using packet header." Neither indication of separate utility is tenable, because the data protection is due to the encryption of the digital contents, and both Group I and Group II perform such encryption, both transmit the encrypted data in a header of a copyright protection protocol classifiable in class 713 subclass 160 (Subject matter wherein the data transfer uses an integral unit including information indicating that the associated data is encrypted or signed.) and both decrypt the copyright protection protocol according to the data in the header.

The Examiner maintains the restriction by stating that Group I has separate utility by "storing key information." Both Group I and Group II perform decryption based on *information* transmitted to *a terminal unit having decryption algorithm* (claim 1) or *a protocol format decoder having decryption algorithm* (claim 20). The storage of the *information* (key information) in claim 1 does

not result in copy protection different from the copy protection afforded by claim 20. The copy protection is due to the **encryption** of the digital contents, and both Group I and Group II perform such encryption, both transmit the encrypted data in a header of a copyright protection protocol classifiable in class 713 subclass 160, and both decrypt the copyright protection protocol according to the *information* transmitted to *a terminal unit having decryption algorithm* (claim 1) or *a protocol format decoder having decryption algorithm* (claim 20).

Accordingly, the restriction/election requirement between the claims of Groups I and II should be withdrawn, because Groups I and II are not subcombinations disclosed as usable together, because they do not have separate utility and because they should be commonly classified.

Additionally, the Examiner errs with respect to the indication of separate utility for Group V in stating that Group V has separate utility "such as control signal protocol" classified in class 380 subclass 239. This subclass is indented under 380/210: Video electric signal modification (e.g., scrambling): Subject matter wherein a video electric signal is made unintelligible by varying at least one of its parameters. Subclass 239 further modifies subclass 210 by requiring subject matter wherein a control coding signal modifying the video electric signal has itself been made unintelligible. No claim of Group V drawn to video, no claim calls for the scrambling or encrypting of a video electric signal, and no claim utilizes an unintelligible control coding signal to modify such a video electric signal.

The Examiner erroneously maintains the restriction by stating that "encrypting digital content and decryption and replay [of] the content is a modification of a video content having code signal." The Examiner fails to explain how the term "digital content" suddenly becomes "video content." As stated above, there is no video claimed in Group V.

Accordingly, without a proper showing that this Group is properly classified in class 380, then the Examiner fails to provide a *prima facie* showing that claims of Group V are restrictable from Groups I and II. Therefore Group V should be examined with Groups I and II.

Also, the Examiner errs with respect to Group VII stating that this group has separate utility "such as copy protection and prevention" classified in class 380 subclass 201. This subclass is indented under 380/200, *i.e.,* VIDEO CRYPTOGRAPHY: Subject matter wherein a video signal representative of a time varying object or image is made unintelligible. Subclass 201 includes subject matter which prevents re-recording of a stored picture signal representative of a time varying object or image. Like Group V, there is no video claimed in the claims of Group VII. Therefore, the claims are not classifiable in class 380 subclass 201.

The Examiner finds it confusing that a claim, having no claim to video, has no video utility and should not be classified in the video art. That is, it appears that the Examiner is of the erroneous belief that the utility of "a method of copy prevention and protection" set forth in Group VII is not similar to the utility of "copy protection" afforded by Group I classified in Class 713, and should somehow be classified in Class 380 even though there is no claim to video.

Accordingly, without a proper showing that this Group is properly classified in class 380, then the Examiner fails to provide a *prima facie* showing that claims of Group VII are restrictable from Groups I and II. Therefore Group VII should be examined with Groups I and II.

Note that Group VII covered by claims 57-65 calls for *an algorithm for decrypting protocol including encrypted digital contents*, and *storing key information.* Group I, covered by claims 1-19 and 37-44 calls for *storing key information* and *decrypting copyright protection protocol using the decryption algorithm and the key information.* Accordingly, Groups I and VII have similar utility

and should be similarly classified.

Further, as stipulated in MPEP §803, if the search can be made without serious burden, the examiner must examine it on the merits. The examiner has not alleged any serious burden, but instead refers to their "separate classification."

It has been shown above that the "separate classification" is due to Examiner error is suggesting that one or more Groups have claims directed to video. Since there is no video being claimed in any of the Groups, then classification for all Groups is in Class 713.

Thus there appears to be no burden on the Examiner in searching of Groups III and IV because the claims are classified in class 713 and contain subject matter found in the elected claims, therefore the examiner must examine the entire application as stipulated in MPEP §803. That is, Groups I-VII all have utility in copyright protection according to a digital content encryption apparatus or method classifiable in class 713.

Accordingly, it has been shown that the Examiner erred in stating that the inventions are subcombinations disclosed as usable together, in stating that each has separate utility, and the Examiner has improperly classified the various claims in different classes and subclasses or in the incorrect classes and subclasses.

## REMEDY REQUESTED



The Commissioner is respectfully requested to:

1. Withdraw the Restriction;

2. Provide a non-final Office action on the merits with respect to claims 1-19 and 34-69;

3. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

Robert E. Bushnell
Attorney for Applicant
Reg. No.: 27,774

1522K Street, N.W.
Washington, D.C. 20005
(202) 638-5740

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